

REMARKS

Claims 1-18 are pending in this application. Claims 1-18 are rejected. Claims 1, 8 and 15 are amended hereby. Claims 4, 5, 11 and 12 have been previously canceled.

Responsive to the objection to claims 1 and 8, Applicants have amended claims 1 and 8, keeping in mind the comments of the Examiner. Applicants respectfully submit that claims 1 and 8 are in allowable form.

Responsive to the rejection of claims 1-3, 6, 8-10, 13, 15, 16 and 18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,968,049 (Da Rold), Applicants have amended claims 1, 8 and 15, and submits that claims 1-3, 6, 8-10, 13, 15, 16 and 18 are now in condition for allowance.

Da Rold '049 discloses milling cutter 1 (Figs. 1 and 2) including milling body 2 which is a dimensionally accurate hemisphere and milling teeth 10 arranged at the correct location in milling body 2 (column 2, lines 48-55). Production (Figs. 3-6) takes place in three operations (column 3, line 13). In the first operation, the blanks made from sheet metal are given the desired shape of milling body 2 by way of deep-drawing or pressing (column 3, lines 13-16). Then, in the second operation, the substantially non-elongated cutouts or openings 15, with a dimensionally accurate reference edge 11 and sharp cutter 13 with sharp cutting edge 18, are formed on the dimensionally accurate milling body 2 using a computer-controlled machine (column 3, lines 16-21). In a third operation, cutting tongue 13 is bent up through angle α about bending edge a, so that cutter 12 is brought into the correct position (column 3, lines 25-28). (Emphasis added).

In contrast, claim 1 as amended recites in part: “forming a shell having a convex side and a concave side and a cutting face in said concave side; ... wherein each said cutting edge extends radially inwardly from said convex side to said concave side; ...”. (Emphasis added). Applicants

submit that such an invention is neither taught, disclosed or suggested by Da Rold '049, or any of the other cited references, alone or in combination, and includes distinct advantages thereover.

Da Rold '049 discloses an acetabular reamer (Fig. 2) with a convex cutting face where the cutting tongue is bent radially outward of the convex cutting face. Da Rold '049, and the other cited references, fail to disclose or suggest a “forming a shell having a convex side and a concave side and a cutting face in the concave side, wherein each cutting edge extends radially inwardly from the convex side to the concave side. To anticipate a claim the reference must teach every element of the claim (MPEP 2131), and as Da Rold '049 fails to disclose or suggest at least the claim limitations discussed above, Da Rold '049 does not anticipate the present invention.

Further, the present invention is not obvious by Da Rold '049 at least because different tooling is needed to bend the cutting edge of the present invention versus the tooling used to bend the cutting tongue Da Rold '049. Yet further, the present invention as presently claimed relates to humeral cutters and femoral head shapers, and Da Rold '049 is completely silent regarding such inventions. The prior art must suggest the desirability of the claimed invention (MPEP 2143.01), and as Da Rold '049 only talks about acetabular reamers, Da Rold '049 fails to suggest the desirability of the claimed invention. Therefore, the present invention is not obvious nor anticipated by Da Rold '049.

Advantages of the present invention include that it provides humeral cutters and femoral head shapers with excellent cutting performance, and which are relatively easy to manufacture.

For all of the foregoing reasons, Applicants submit that claim 1, and claims 2, 3 and 6, depending therefrom, are now in condition for allowance, which is hereby respectfully requested.

Similarly, claim 8, as amended, recites in part: “wherein said shell has a convex side and a concave side and said cutting face being in said concave side, and each said cutting edge extends

radially inwardly from said convex side to said concave side.”. (Emphasis added). For all of the reasons given above with regard to claim 1, Applicants submit that claim 8, and claims 9, 10 and 13 depending therefrom, are now in condition for allowance, which is hereby respectfully requested.

Similarly, claim 15, as amended, recites in part: “a shell having a convex side and a concave side and a cutting face in said concave side; … wherein each said cutting edge extends radially inwardly from said convex side to said concave side.”. (Emphasis added). For all of the reasons given above with regard to claim 1, Applicants submit that claim 15, and claims 16 and 18 depending therefrom, are now in condition for allowance, which is hereby respectfully requested.

Responsive to the rejection of claims 7, 14 and 17 under 35 U.S.C. § 103(a) as being obvious by U.S. Patent No. 5,968,049 (Da Rold), Applicants have amended claims 1, 8 and 15, and submit that claims 7, 14 and 17 are now in condition for allowance. The amendments to claims 1, 8 and 15 discussed above distinguish claims 1, 8 and 15, and any dependent claims including claims 7, 14 and 17, from the prior art including Da Rold ‘049. For all of the foregoing reasons, Applicants submit that claims 1, 8 and 15, and claims 7, 14 and 17 depending therefrom, are now in condition for allowance, which is hereby respectfully requested.

For the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the amended claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally

petition therefor and authorizes that any charges be made to Deposit Account No. 20-0095,
TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to
telephone the undersigned at (260) 897-3400.

Respectfully submitted,

Todd T. Taylor
Registration No. 36,945

Attorney for Applicant

CERTIFICATE OF MAILING

TTT7/bd

TAYLOR & AUST, P.C.
142 S. Main Street
P.O. Box 560
Avilla, IN 46710
Telephone: 260-897-3400
Facsimile: 260-897-9300

Enc.: Return postcard

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: May 22, 2006.

Todd T. Taylor, Reg. No. 36,945
Name of Registered Representative

Signature

May 22, 2006

Date